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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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IN RE APPLICATION OF:

Yasuhiro IWAMURA, et al.

: EXAMINER: KEITH, J

SERIAL NO: 09/981,983

:

FILED: October 19, 2001

: GROUP: 3641

FOR: NUCLIDE TRANSMUTATION DEVICE
AND NUCLIDE TRANSMUTATION METHOD

**RESPONSE TO RESTRICTION AND
ELECTION OF SPECIES REQUIREMENTS**

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

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SIR:

In response to the Restriction Requirement stated in the Official Action dated April 14, 2003, Applicants provisionally elect Group (Invention) I, Claims 1-6, drawn to an apparatus (transmutation device), classified in class 376, subclass 100. Furthermore, in response to the Election of Species Requirement stated in the same Official Action, Applicants provisionally elect Species (A) as shown in Figure 3, Species (b) as shown in Figures 2, 4-6 and 11, Species (bii) as shown in Figures 5A and 5B, Species (iii), Species wherein the substrate (23) is consisting of Pd, and the mixed layer (22) is consisting of Pd and CaO, and the surface layer (21) is consisting of Pd, and Cs¹³³ as the transmutation nuclide material, and identify Claims 1-6 as readable on the elected Species.

However, Applicants respectfully traverse the outstanding Restriction and Election of Species Requirements for the following reasons.

First, the outstanding Office Action states that “[t]he inventions are distinct, each from the other...,” simply because “[i]n this case the process as claimed can be practiced by another materially different apparatus such as the transmutation of nuclides by utilizing a charged particle beam apparatus or a sonofusion apparatus.” However, without any further information, such a finding lacks basis upon which it can be evaluated whether in fact the proposed alternative is “materially different” under MPEP §806.5(e). Accordingly, it is respectfully submitted that the PTO has not carried its burden of proof to establish distinctness.

In addition, the Restriction Requirement asserts that the application contains claims to patentably distinct inventions. However, MPEP §803 states the following:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

In the present application, Claims 1-6 are directed to a nuclide transmutation device, while Claims 7-9 are directed to a nuclide transmutation method. Also, according to the outstanding restriction requirement, the alleged inventions, I and II, are classified in the same class, 376. Hence, it appears that all claims in the present application are part of an overlapping search area and that a search for Claims 1-6 would necessarily include the subclass required for a search directed to Claims 7-9. It is therefore believed that there is no undue burden on the Examiner to search all claims under MPEP §803, and Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Furthermore, Applicants respectfully traverse the series of Election of Species Requirements for several reasons.

The outstanding Office Action asserts that “[t]his application contains claims directed to the ... patentably distinct species of the claimed invention....” However, MPEP §816 states the following:

If the particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given....

The outstanding Election Requirements merely provide the aforementioned conclusory statement and do not present particular reasons for such a holding. Hence, Applicants respectfully submit that in the absence of any annunciated basis, the PTO has not carried its burden of proof stated in MPEP §816.

Further, MPEP §806.04(f) states:

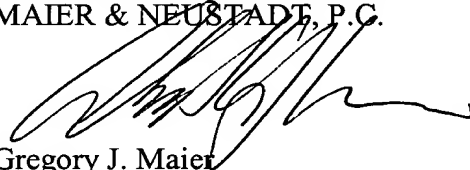
Claims to be restricted to different species must be mutually exclusive.

The outstanding Election Requirement omits any statement or basis for finding the Claims “mutually exclusive.” Therefore, the PTO has not carried the burden implied by MPEP §806.04(f), and on that basis, Applicant further traverses the Election Requirements.

Accordingly, it is respectfully requested that the outstanding Restriction and Election of Species requirements be withdrawn, and that a full examination on the merits of each of Claims 1-9 be conducted.

Respectfully submitted,

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